

## **AMENDMENTS TO THE FIGURES**

Applicant has made a change to Figure 1 by labeling Figure 1a "PRIOR ART." Applicant has also made a change to each of Figures 2 and 3 by labeling each of Figures 2 and 3 as "PRIOR ART." Applicant has changed Figure 4 by removing reference character "405" and has changed Figure 5 by removing reference character "505".

Applicant submits the attached three (3) sheets of drawings as Replacement Sheets.

## **REMARKS**

The Office Action dated December 29, 2004, and the patents and published patent applications cited therein have been carefully reviewed, and in view of the changes to the drawings and following remarks reconsideration and allowance of all the claims pending in the application are respectfully requested.

Applicant wishes to draw the Examiner's attention to cited reference D, U.S. Patent No. 6,005,739 to Yun, appearing in the PTO-892 accompanying the Office Action dated December 28, 2004, and to the Examiner's remarks on page 5 at lines 12 – 13 of the Office Action in which U.S. Patent No. 6,005,736 to Schreck is identified. Applicant respectfully submits that the Examiner may have intended to cite U.S. Patent No. 6,005,736 to Schreck in the PTO-892 rather than the U.S. Patent No. 6,005, 739 to Yun. If so, Applicant respectfully requests that the examiner make U.S. Patent No. 6,005,736 to Schreck of record.

### **The Objection To The Drawings**

The drawings stand objected-to as failing to comply with 37 C.F.R §1.84(p) because they include reference characters that are not mentioned in the description.

Applicant has made a change to Figure 1 by labeling Figure 1 a "PRIOR ART." Applicant has also made a change to each of Figures 2 and 3 by labeling each of Figures 2 and 3 as "PRIOR ART." Applicant has changed Figure 4 by removing reference character "405" and has changed Figure 5 by removing reference character "505".

Lastly, the Examiner has indicated that the reference character "1206" of Figure 12 is not mentioned in the description. Applicant respectfully submits that reference character "1206" of Figure 12 is identified at line 17 of paragraph 51 on page 17 of the specification.

Consequently, Applicant respectfully requests that the Examiner approve the requested drawing changes to Figure 1 – 5 (sheets 1 – 3) and withdraw the objection to the drawings.

### **The Rejection Based On Double Patenting**

Claims 1 -22 stand provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1 -22 of co-pending U.S. Patent Application 10/691,742.

Applicant has submitted concurrently with this response a Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over a Pending Reference Application and a Fee Transmittal authorizing the Commissioner For Patents to debit a deposit account.

Consequently, Applicant respectfully requests that the Examiner withdraw this rejection.

### **The Rejection Under 35 U.S.C. 103(a) over Feng In View of Kuroda**

Claims 1 and 10-12 stand rejected under 35 U.S.C §103(a) as being unpatentable over Feng et al. (Feng), U.S. Patent No. 6,529,342 B1, in view of Kuroda et al. (Kuroda), U.S. Patent No. 5,546,374. Applicant respectfully submits that the present invention according to any of claims 1 and 10 -12 is patentable over Feng in view of Kuroda. Applicant respectfully submits that the applied patents are not properly combinable to form a basis for rejection of these claims.

Contrary to the Examiner's statement, there simply is no suggestion in either Feng or Kuroda "to implement Kuroda's et al. technique to the technique disclosed in Feng's et al. because it would provide Feng's system with the enhanced capability of performing reproduction with high signal to noise ratio." In fact, Applicant respectfully submits that Feng and Kuroda teach away from each other. In particular, Feng relates to a method for controlling the flying height at the interface of a magnetic head and a magnetic storage medium ( see Feng, column 1, lines 9 -12). Feng states that the magnetic head applies magnetic fields to the magnetic storage medium to record data and also detects magnetic fields from the magnetic storage medium to reproduce data ( See Feng, column 3, lines 25 – 27). In contrast, Kuroda relates to an information recording and/or reproducing apparatus for recording and/or reproducing information with probes being in contact with a recording medium that is made of a material that locally oxidizes at the surface of the recording medium upon application of a voltage through the probe ( See Kuroda, column 1, lines 10 -13, and column 3, lines 17 -21).

Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not even consider implementing the techniques disclosed by Kuroda in the system disclosed by Feng because the respective storage mediums are different.

Applicant respectfully submits that the proffered combination of Feng and Kuroda is formed by implementing hindsight because neither Feng nor Kuroda suggest the combination. Thus, Applicant respectfully submits that it is only by impermissible hindsight that the Examiner is able to reject claims 1 and 10 – 12 based on the proffered combination because neither of the applied patents provides a proper suggestion for combination. It is only by the Applicant's disclosure that the Examiner can select particular features of Feng and Kuroda to make the rejection.

Consequently, Applicant respectfully requests that the Examiner withdraw this rejection and allow claims 1 and 10 – 12.

### **The Rejection Under 35 U.S.C. §103(a) Over Feng In View of Kuroda And In Further View Of Chapin**

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Fen in view of Kuroda, further in view of Chapin et al. (Chapin), U.S. Patent No. 6,785,081 B2.

Applicant respectfully submits that the present invention according to claim 4 is patentable over Feng in view of Kuroda, further in view of Chapin. Applicant respectfully submits that Chapin does not cure the deficiencies of Feng and Kuroda with respect to a motivation for their combination in regard to claim 1, the base claim for claim 4.

Consequently, Applicant respectfully requests that the Examiner withdraw this rejection and allow claim 4.

### CONCLUSION

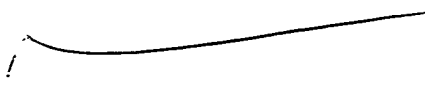
In view of the above amendments to the drawings and arguments regarding patentability, it is urged that the present application is now in condition for allowance. Should the Examiner find a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below.

A general authorization under 37 C.F.R §1.25(b), second sentence, is hereby given to credit or debit Deposit Account No. for the instant filing and for any other fees during the pendency of this application under 37 C.F.R §§1.16, 1.17 and 1.18.

It is requested that this application be passed to issue with claims 1 – 22.

Respectfully submitted,  
WAGNER, MURABITO & HAO LLP

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